

## **REMARKS**

### **I. Introduction**

Applicant respectfully requests reconsideration of the application in light of the above-noted amendments and the arguments to appear hereinafter.

### **II. New Matter Objection under 35 U.S.C. § 132**

Examiner objects to the amendment filed on May 22, 2003 under 35 U.S.C. § 132 because it introduces new matter into the disclosure. Examiner specifically states that the “spring bias teeth” and the “spring bias pin” are not supported by the original disclosure. Based on this statement, Examiner has required Applicant to cancel this new matter. Applicant respectfully traverses this objection. Applicant respectfully directs Examiner’s attention to page 6 of the original application. In the paragraph beginning “Referring now to Figures 3 and 6,” Applicant notes that on line 19, “spring bias teeth” are cited as an alternative to screw 40. Additionally, on line 20, the “spring bias pin” is also cited as an alternative to screw 40. Thus, neither the “spring bias teeth” nor the “spring bias pin” are new matter because both were included within the specification since the onset of the prosecution process. Hence, Applicant respectfully requests that Examiner withdraw her requirement that Applicant cancel these terms.

### **III. Rejection of Claim 13 under 35 U.S.C. § 112, First Paragraph**

Claim 13 stands rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Examiner states that the subject matter of claim 13, specifically the “ball lock,” was not described in the specification in a manner to convey that the inventor had possession of the claimed invention and thus constitutes new matter. Applicant respectfully traverses this rejection on the grounds that a ball lock is old and well-known in the art. Applicant does not claim to have invented a ball lock; Applicant does claim

the use of a ball lock within the confines of his invention, not a ball lock standing alone. Furthermore, on page 5 in paragraph 7, Examiner herself states "The examiner takes Official Notice that the use of a ball lock...as a locking mechanism is notoriously old and well known in the art." In light of Examiner's own admission, as well as Applicant's arguments, that claiming a ball lock for use with the invention does not introduce new matter because it is known in the art, Applicant respectfully requests that Examiner withdraw her rejection.

**IV. Objection to the Drawings under 37 C.F.R. § 1.83(a)**

Examiner objects to the drawings under 37 C.F.R. § 1.83(a) because the use of "spring biased teeth" and a "spring biased pin" in accordance with the invention has been claimed but not illustrated in the drawings. Applicant believes he has overcome this objection through amendment with the addition of Figures 14 and 15 that depict a spring biased pin and spring biased teeth, respectively. Applicant has not added any new matter with the introduction of these additional figures. In light of Applicant's amendments, Applicant respectfully requests that Examiner withdraw her objection.

Examiner disapproves of the proposed drawing corrections filed on May 22, 2003 for a lack of clarity and because Examiner contends that new matter [i.e. the spring biased teeth and spring biased pin] has been added. Applicant has resubmitted the drawing corrections for Examiner's approval. Furthermore, in light of the arguments in Section III, Applicant has not added any new matter with the proposed drawing corrections. Additionally, Examiner has required that Figures 7, 8, and 9 include screw 40 as originally filed. Applicant has changed these figures to include screw 40. Applicant respectfully requests that Examiner approve the proposed drawing corrections in light of these arguments and amendments.

**V. Objection to Claims 19 and 20 for being Directed to a Non-Elected Species**

Examiner has requested that Applicant withdraw claims 19 and 20 because they are directed to a non-elected species. Applicant has withdrawn claims 19 and 20 as requested. Applicant thanks Examiner for her admonition to include a listing of all claims readable on the elected embodiment when claims are subsequently added; Applicant does note that such a listing was included with his last response.

**VI. Rejection of Claims 1 and 17 under 35 U.S.C. § 112, Second Paragraph**

Claims 1 and 17 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Applicant respectfully traverses this rejection. With respect to claim 17, the rejection is moot because claim 17 has been cancelled. Respecting claim 1, Examiner specifically points to this language in the claim as being a source of confusion: “a fastener removable supported on said tool”. It appears from Examiner’s interpretation that Examiner believes that the term “tool” in the cited language refers back to the “pole apparatus” in the preamble of claim 1. In fact, the term “tool” does not refer to “pole apparatus,” but instead refers to the following language in body of claim 1: “a tool having a mounting portion adapted to engage said first connector and being removably secured to said first connector by said locking apparatus.” Thus, in light of this clarification, Applicant respectfully requests that Examiner withdraw her rejection.

**VII. Rejection of Claims 1, 2, 7, 11 and 12-17 under 35 U.S.C. § 103(a)**

Claims 1, 2, 7, 11 and 12-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,154,104 (the “‘104 patent”) issued to O, in light of U.S. Patent No. 1,417,683 (the “‘683 patent”) issued to Parsons. Applicant respectfully traverses this rejection in light of the following arguments.

The Federal Circuit, in *In re Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (CAFC 2002), stated that with respect to obviousness, “the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching...to select and combine the references relied on as evidence of obviousness,” (*Id.* at 1343, citing *McGinley v. Franklin Sports*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008 (CAFC 2001)). In addition, the factual inquiry whether to combine references must be thorough, searching and must be based on the objective evidence of record, *Id.* (emphasis added). The court further notes that “the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references,” *Id.*, citing *In re Dance*, 160 F.3d 1399, 1343, 48 U.S.P.Q.2d 1635, 1637 (CAFC 1998). Finally, with respect to the need for specificity in an obviousness rejection, the Federal Circuit states that “the examiner can satisfy the burden of showing obviousness of the combination **only** by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references,” *Id.*, citing *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (CAFC 1992) (emphasis added). In sum, upon making a rejection based on obviousness, the burden is upon the examiner to produce evidence on record showing that the cited art affirmatively teaches or motivates one of skill in the art to create the combination. This evidence is required to defend against the temptation of a hindsight-based obviousness rejection.

O discloses an apparatus for installing ceiling-mounted elements while enabling the installer to remain on the ground (col. 1, lines 44-46). In the preferred embodiment, the apparatus includes a telescoping housing section (Figs. 1-7; col. 3, lines 21-22). An adapter element is attached to one end of the telescoping housing section (Figs. 1-5; col. 3, lines 24-

25 and lines 29-35). This adapter element is configured for attachment to a hand-held power tool, such as a drill (col. 3, lines 29-33). A ceiling-mounted element attaching section is attached to the other end of the telescoping housing section (Figs. 1-5; col. 3, lines 23-26). The ceiling-mounting element attaching section has an internally stepped wall defining three sections (Fig. 12; Fig. 16; col. 4, lines 9-17). The first section is sized to operate as a 9/16-inch socket wrench; the second section is sized to operate as a 1/2-inch socket wrench; and the third section is sized to operate as a 7/16-inch socket wrench (col. 4, lines 11-17). The internally stepped wall is configured to receive a first fastener, such as a screw or a bolt, where the fastener is affixed to the ceiling as part of the ceiling construction process (Figs. 8-9; Fig. 12; Figs. 14-16; col. 3, lines 25-27; col. 4, lines 35-40). An additional fastener, such as a hex nut, is used to selectively secure the first fastener to the ceiling-mounting element attaching section until the first fastener is inserted into the ceiling for the ceiling construction process (col. 4, lines 35-40). The ceiling mounted element attaching section further includes a threaded bore located on the opposite end of the internally stepped wall (Fig. 8; col. 4, lines 7-9). This threaded bore engages a threaded rod that extends within the telescoping housing section (Fig. 11; col. 4, lines 27-31).

When the tool is used, it is usually necessary to adjust the length of the telescoping housing section to allow the user to secure a fastener on a ceiling. To adjust the length of the telescoping housing section, the user twists the threaded rod as necessary to achieve the desired length (col. 4, lines 44-46). The user connects a drill to the adapter end of the tool, and once the drill is activated, the threaded rod and portions of the telescoping housing rotate with the drill (col. 4, lines 54-57). The first fastener, such as a bolt, is situated in the internally stepped wall of the ceiling-mounting element attaching section (col. 4, lines 51-55).

The user raises the tool, places the first fastener on the desired location on the ceiling, and then actuates the drill to affix the first fastener in the ceiling (col. 4, lines 45-58).

To summarize the teachings of the '104 patent most pertinent to this response, a user desiring to attach a fastener to a ceiling can attach a drill to the adapter end of the tool disclosed in the '104 patent. At the other end of the tool, the user places the fastener in the tool's internally stepped wall, which is located on the opposite end of the adapter. The internally stepped wall, in the preferred embodiment, acts as a socket wrench and is configured to fasten nuts and bolts to a ceiling. However, if the user desires to attach a different type of fastener to the ceiling, such as a screw, the user must disassemble the ceiling-mounting element attaching section having an internally stepped wall similarly configured to that of a wrench and replace it with one configured to that of a screwdriver.

Applicant's invention discloses a pole apparatus that is typically used to assist an installer with the installation of a suspended ceiling. In one embodiment, the pole apparatus has a telescoping body. At one end of the telescoping body is a first connector having a locking mechanism. The first connector has a bore that is adapted to receive a tool. This tool can be a variety of instruments, including a screwdriver or a wrench. Every type of tool will have a mounting portion configured for insertion into the first connector. In other words, the mounting portions of every type of tool will be substantially the same, thus the first connector does not need to be replaced when a different tool is needed. A fastener, such as a bolt or a spring bias pin, is used to keep the tool in place. At the other end of the telescoping body is a second connector configured to engage with a rotary tool, such as a drill.

At least one important difference between Applicant's invention and the teachings of the '104 patent is that the user of Applicant's invention does not ever have to disassemble any of the connectors in order to change tools. All an installer need do to change tools is to

simply unfasten the tool, remove the tool from the first connector, and reinsert a new tool. The installer need not change the first connector when using Applicant's invention; however, a user using the device disclosed in the '104 patent must go through the step of changing the ceiling-mounting element attaching section.

In an obviousness rejection, Examiner must show that the cited art teaches Applicant's device. Yet in the case of the '104 patent, the art actually *teaches away* from Applicant's device. The '104 patent, in its explanation of the operation of the device, contains clear language explaining the benefit of having ceiling-mounting element attaching section:

After the bolt is set into the ceiling, the power tool can be set on reverse and activated to rotate in direction 23". This will back the tool off of the bolt by unscrewing the coupling element 22 from the bolt. The bolt will be engaged with the ceiling with a greater degree of frictional fit than with the [ceiling-mounting element attaching section] 22 so the unscrewing motion will not remove the bolt from the ceiling but will remove the tool from the bolt (col. 4, lines 58-65).

The '104 patent teaches that the ceiling-mounting element attaching section provides the important feature of automatically disengaging itself from the bolt just fastened into the ceiling when the user reverses the direction of the power tool. Clearly, this important feature could not be accomplished on Applicant's invention because Applicant does not have a ceiling-mounting element attaching section. Furthermore, nowhere within the '104 patent is there any suggestion for the use of Applicant's first connector for interchangeable use with a tool. In light of the principles espoused by the Federal Circuit in *In re Lee*, and in light of the evidence showing that the '104 patent actively teaches away from Applicant's invention, Applicant respectfully requests that the rejection of claims 1, 2, 7, 11 and 12-17 be withdrawn.

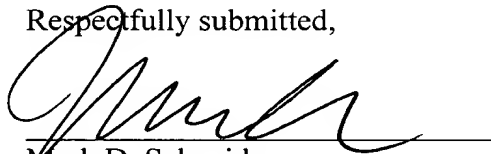
**VIII. Rejection of Claims 18 and 21-22 under 35 U.S.C. § 103(a)**

Claims 18 and 21-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over O in light of Smith, Yorde or Osborn. Applicant respectfully traverses this rejection in light of the arguments above and requests that Examiner allows the above-mentioned claims.

**IX. Rejection of Claim 23 under 35 U.S.C. § 103(a)**

Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over O in light of Parsons, in further view of Smith, Yorde or Osborn. Applicant respectfully traverses this rejection in light of the arguments above and requests that the above-mentioned claim be allowed.

Respectfully submitted,



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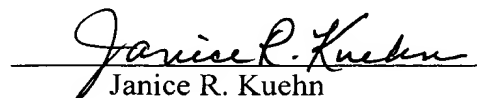
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